

## REMARKS

Claims 1, 9-17, and 20-32 are pending in the application.

In the non-final third Office Action mailed on December 21, 2005, the Examiner rejected claims 1, 3, 5-8, 11-13, 20-24, 31 and 32, and allowed claims 10, 14-17 and 26-30. Also, claim 9 was objected to, and claim 24 was indicated to be allowable if amended to overcome a rejection under U.S.C. §112, second paragraph.

The drawings filed on December 9, 2003 and April 25, 2005 were accepted.

By way of this paper, claims 3, 5, 6, and 7 are cancelled. Also, claims 1, 20 and 24 are amended.

### Claim Rejections – 35 U.S.C. § 112

Claims 20-24 were rejected under 35 U.S.C. §112, second paragraph.

#### 1. The '112 rejection should be removed.

Claims 20 and 24 are amended as follows:

*wherein the predetermined percentage of the carrier that is removed from the recording element by the ~~first station~~ carrier removal station is a minimum amount necessary to prevent blistering of the recording element at the ~~second station~~ converting station when the inherent durability characteristic of the recording element is increased at the ~~second station~~ converting station.*

The last subparagraph in claims 20 and 24 as amended makes such subparagraph identical with the last subparagraph in previously presented claims 1 and 10. The last subparagraph in previously presented claims 1 and 10 were not rejected under '112, as were claims 20 and 24. Thus, the '112 rejection of claims 20 and 24 should be removed.

#### 2. The Examiner's statement in the '112 rejection that the last subparagraph in claims 20 and 24 "does not appear to have the meaning intended by applicant" is not believed to be correct.

Moreover, the last subparagraph in claims 20 and 24 as amended is fully consistent with the description in the specification, and as such is fully supported by the specification. For example, in the published application US 2005/0122382A1 see [0083] wherein it is stated that "the percentage of carrier

removed is the minimum amount necessary to prevent defects from occurring after the durability characteristic of the recording element 38 has been altered (for example, increased) by converting station 24". Also, see [0109]-[0116] including TABLE 1 and "The above results also show that the amount of carrier removed has a direct effect on blistering during the converting step. If too much carrier remains in the sample after the carrier removal step, then blistering is observed. In this example, at least about 85 wt. % of the carrier needed to be removed in order to prevent blistering. In general, the minimum amount of carrier that needs to be removed will vary depending on the particular compositions of the ink and recording element, as well as the conditions employed in the carrier removal and converting steps." in [0116]. Thus, the Examiner's statement in the '112 rejection that the last subparagraph in claims 20 and 24 "does not appear to have the meaning intended by applicant" is not believed to be correct, because the last subparagraph in claims 20 and 24 is consistent with the foregoing excerpts and as such is supported by the specification.

#### **Claim Rejections – 35 U.S.C. § 102**

Claims 1, 3, 5, 7-8, 11 and 13 were rejected under 35 USC 102(b) as being anticipated by Vincent et al. '846. Claims 3, 5 and 7 are now cancelled.

#### **1. The Examiner's rejection of claim 1 appears to be based on an earlier version of claim 1 which is no longer current, rather than on the last-amended version of claim 1.**

The Examiner's rejection, in part, stems from his statement "It is noted that applicant's use of the term "based on" does not provide any definite relation between the minimum amount to prevent blistering and the percentage of carrier that is removed". However, this statement appears to ignore the fact that the term "based on" was removed from previously presented claim 1 in an earlier amendment to that claim. See the Amendment filed October 6, 2005 in response to the earlier Office Action mailed July 21, 2005, which deletes the term "based on".

Accordingly, the rejection is believed to be in error.

#### **2. Claim 1 is not anticipated by Vincent et al.**

Vincent et al. discloses an apparatus for treating a print medium, including a drying heater 70 that dries each print line on the print medium almost

immediately after the ink is applied to the print medium. See Vincent et al., col. 3, lines 15-17, and col. 4, lines 2-5. The heater 70 is construed by the Examiner to be the "carrier removal station" in previously presented claim 1. As described in Vincent et al., col. 4, line 64 – col. 5, line 2, and col. 5, lines 15-25, the heater 70 does not dry the print medium 100%. The heater 70 dries the ink "sufficiently to prevent puddling". See Vincent et al., col. 4, line 24-25. Moreover, the heater 70 must leave sufficient moisture in the print medium for removal of cockle by a pair of heated rollers 130 and 150. See Vincent et al., col. 5, lines 15-25. The Examiner construes the heated rollers 130 and 150 to be the "converting station" in previously presented claim 1. Further drying to dry the print medium 100% is accomplished by the heated rollers 130 and 150. See Vincent et al., col. 5, lines 9-13.

Since the heater 70 dries the ink "sufficiently to prevent puddling" and leaves sufficient moisture in the print medium for removal of cockle by the heated rollers 130 and 150 in Vincent et al., this is not the same as the last subparagraph in previously presented claim 1 which recites that "the predetermined percentage of the carrier that is removed from the recording element by the carrier removal station is a minimum amount necessary to prevent blistering of the recording element at the converting station when the inherent durability characteristic of the recording element is increased at the converting station". The prevention of "puddling" and leaving sufficient moisture "for removal of cockle" in Vincent et al. clearly is not the same as the prevention of blistering in previously presented claim 1. This difference has not been addressed by the Examiner in his rejection.

The Examiner's argument that the last subparagraph in previously presented claim 1 is "inherent" in Vincent et al. is not correct. This is demonstrated in the previous paragraph, owing to the difference between the prevention of "puddling" and leaving sufficient moisture "for removal of cockle" in Vincent et al. and the prevention of blistering in previously presented claim 1.

The Examiner asserts that "With respect to the predetermined portion of the carrier that is removed being based on a minimum amount that needs to be removed to prevent blistering, this determination is a functional expression" in the last subparagraph in previously presented claim 1. In other words, it appears that the Examiner has chosen to ignore the last subparagraph in previously presented claim 1, when rejecting that claim. Notwithstanding that the last subparagraph in

previously presented claim 1 is not a functional limitation, the last subparagraph is amended as follows:

*wherein the carrier removal station is further adapted to remove the predetermined percentage of the carrier that is removed from the recording element by the carrier removal station is a minimum amount necessary to prevent blistering of the recording element at the converting station when the inherent durability characteristic of the recording element is increased at the converting station.*

This should remove any reservation by the Examiner that the last subparagraph is a functional limitation.

Accordingly, Vincent et al. does not anticipate amended claim 1.

3. Dependent claims 8, 11, 13, 31, and 32.

Claims 8, 11 and 13, which are dependent on claim 1, are patentable over Vincent et al. at least for the reasons above that claim 1 is patentable over Vincent et al.

The same is true for claims 31 and 32.

**Claim Rejections – 35 U.S.C. § 103**

Claim 6 was rejected under 35 USC 103(a) as being unpatentable over Vincent et al. '846, as applied to claim 1 above, and further in view of Ferran et al. '396. Claim 6 is cancelled.

Claims 20-23 were rejected under 35 USC 103(a) as being unpatentable over Vincent et al. '846.

1. Claim 20 is not obvious in view of Vincent et al.

Claim 20 is not obvious in view of Vincent et al. for the same reasons that claim 1 is not anticipated by Vincent et al. See the remarks above regarding claim 1 and Vincent et al. Since the heater 70 dries the ink "sufficiently to prevent puddling" and leaves sufficient moisture in the print medium for removal of cockle by the heated rollers 130 and 150 in Vincent et al., there is no motivation or suggestion in Vincent et al. or elsewhere to modify Vincent et al. reference as instructed by the last paragraph in previously presented claim 20 -- which recites that "the predetermined percentage of the carrier that is removed from the recording element by the carrier removal station is a minimum amount necessary to prevent blistering of the recording element at the converting station

when the inherent durability characteristic of the recording element is increased at the converting station". How can it be obvious to one of ordinary skill in the art to modify Vincent et al. to arrive at claim 20, since the motivation to do so is clearly lacking in the record? The Examiner's mention of using less energy to reduce costs appears to be misplaced. Instead, the rejection of claim 20 appears to be an impermissible hindsight rejection.

Also, the last subparagraph in claim 20 is a method limitation, and as such must be given full weight in examining the claim. Thus, the Examiner's reference to it as a "functional recitation" is not understood.

Accordingly, the Examiner has failed to establish a prima facie case for obviousness, as is required.

2. Dependent claims 12, 22, and 23.

Claims 22 and 23, which are dependent on claim 20, are patentable over Vincent et al. at least for the reasons above that claim 20 is patentable over Vincent et al.

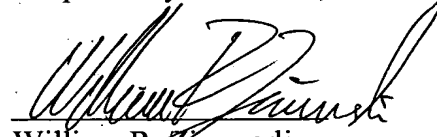
The same is true for claim 12.

CONCLUSION

It is respectfully submitted that, in view of the foregoing amendments and remarks, this application is now in condition for allowance.

The Examiner is invited to call the undersigned attorney in the event that a telephone interview will expedite prosecution of this application towards allowance.

Respectfully submitted,

  
William R. Zimmerli  
Attorney for Applicant(s)  
Registration No. 45,287

WRZ/ld  
Rochester, NY 14650  
Telephone: (585) 588-2758  
Facsimile: (585) 477-4646

If the Examiner is unable to reach the Applicant(s) Attorney at the telephone number provided, the Examiner is requested to communicate with Eastman Kodak Company Patent Operations at (585) 477-4656.